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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,853	10/23/2003	Diane McGhee	S-8135-CIP2 (1502-120 CIP	6726
55825	7590	03/03/2006	EXAMINER	
CARTER, DELUCA, FARRELL & SCHMIDT, LLP 445 BROAD HOLLOW ROAD SUITE 225 MELVILLE, NY 11704			WOODWARD, ANA LUCRECIA	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 03/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,853

Applicant(s)

MCGHEE, DIANE

Examiner

Ana L. Woodward

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 16, 2005
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 5, 13, 14, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 5, 13, 14, 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 16, 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,558,900 (Fan et al) or U.S. 4,467,073 (Creasy).

Fan et al disclose lubricious coatings for medical devices comprising 1) a water-soluble poly(ethylene oxide) polymer, optionally in admixture with other water-soluble polymers, such as polyvinyl pyrrolidone, said water-soluble components reading on the presently claimed hydrophilic polymer 2) an isocyanate-terminated prepolymer, reading on the presently claimed prepolymer and 3) inert organic solvents and mixtures thereof, embracing the presently claimed solvent and alkylester of a carboxylic acid. Suitable solvents include dichloromethane (methylene chloride), dimethylformamide, tetrahydrofuran and ethyl acetate (column 4, lines 21-30). More than one solvent can be employed. Other suitable additives include antimicrobial agents, anti-thrombogenic agents and antibiotics, reading on the presently claimed

Art Unit: 1711

pharmacological additive (column 2, lines 63-67). While Fan et al exemplify solvent mixtures of dichloromethane and toluene (examples 54-60), they do not expressly exemplify mixtures of dichloromethane with an alkylester of a carboxylic acid.

Creasy discloses coating compositions for medical devices comprising polyvinylpyrrolidone, reading on the presently hydrophilic polymer, an isocyanate prepolymer, reading on the presently claimed isocyanate-terminated prepolymer, solvents, embracing the presently claimed solvent and alkylester of a carboxylic acid, and biocides, reading on the presently claimed pharmacological additive. Suitable solvents include alkylesters such as ethyl lactate and ethyl acetate (example II) as well as methylene chloride (column 2, lines 62-66). So long as miscible solvents are used, more than one solvent may be employed. While Creasy exemplifies solvent mixtures of ethyl lactate and methyl ethyl ketone (example II), he does not expressly exemplify mixtures of ethyl lactate with applicants' specific solvent.

In essence, the cited references differ from the present claims in not expressly exemplifying applicants' solvent and alkylester of a carboxylic acid in combination as the solvent component. It would have been obvious to one having ordinary skill in the art and within the scope of Fan et al and Creasy's inventions to employ a solvent mixture comprising both an alkylester of a carboxylic acid and applicants' solvent for their expected additive effect with the reasonable expectation of success. In this regard, it is again noted that each of the references clearly teaches that more than one solvent can be employed. Applicants' claimed solvent and alkylester of a carboxylic acid is taught by the prior art to be useful for the same purpose. Accordingly, it would have obvious to combine said two materials in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows

Art Unit: 1711

logically from their having been individually taught in the prior art. Absent evidence of unusual or unexpected results relative to the combined use of the solvent and the alkylester of a carboxylic acid of the present claims, no patentability can be seen in the presently claimed subject matter.

Response to Arguments

4. Applicant's arguments filed December 16, 2005 have been fully considered but they are not persuasive in overcoming the rejections based on Fan et al and Creasy.

Applicants' claimed solvent and alkylester of a carboxylic acid are individually taught by the prior art to be useful for the same purpose. Furthermore, each of the references clearly teaches that more than one solvent can be employed. Accordingly, it would have obvious to combine said two materials in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. Absent evidence of unusual or unexpected results relative to the combined use of the solvent and the alkylester of a carboxylic acid of the present claims, no patentability can be seen in the presently claimed subject matter.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

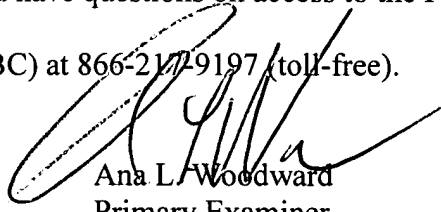
Art Unit: 1711

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Primary Examiner
Art Unit 1711
